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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,375	09/15/2000	Carl-Martin Bell	65-99	2748

23713 7590 12/19/2002

GREENLEE WINNER AND SULLIVAN P C  
5370 MANHATTAN CIRCLE  
SUITE 201  
BOULDER, CO 80303

EXAMINER

LUKTON, DAVID

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 12/19/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/677,375

Applicant(s)

Bell

Examiner

David Lukton

Art Unit

1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 7, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above, claim(s) 20-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-19 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Applicants' election of Group I with traverse is acknowledged. Responsibility for examination of this application has been transferred from Leslie Deak to the undersigned. Accordingly, the restriction is revised, as set forth below.

\*

Restriction to one of the following inventions is required under 35 U.S.C. §121 (the groups begin with number 4, to avoid any conflict with the earlier numbering system):

4. Claims 1-5, drawn to a mixture of peptides in which branched peptides are excluded.
5. Claims 1-5, drawn to a mixture of peptides in which at least one branched peptide must be present
6. Claims 6-13, drawn to an adsorbent in which the "ligand" excludes branched peptides.
7. Claims 6-13, drawn to an adsorbent in which the "ligand" must include at least one branched peptide
8. Claims 14-19, drawn to a device which contains the absorbent of Group 6
9. Claims 14-19, drawn to a device which contains the absorbent of Group 7.

The claimed inventions are distinct.

Inventions {1, 2} and {3, 4} are related as mutually exclusive species in intermediate-final

product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP section 806.04(b), 3rd paragraph), and the species are patentable distinct (MPEP section 806.04(h)). Group 4 is drawn simply to a mixture of linear peptides. Claim 1 could be interpreted to mean that the peptide itself must have an isoelectric point above 7.2, or else that the peptide must simply contain at least one amino acid which is His, Lys, Arg or Tyr. Certainly, according to the latter interpretation claim 1 is not novel; for example, hydrolyzed collagen would probably meet the limitations of claim 1. Group 5 requires the presence of branched peptides. Branched polylysine has been known for more than 20 years (see, e.g., Denkwalter, U.S. Patent 4,289,872). In addition, if one were to prepare an immunoconjugate between a peptide and an antibody, the result would be a mixture of branched peptides having non-identical molecular weight. Furthermore, immunologists use polylysine, branched or unbranched, for raising antibodies to haptens. Thus, there are probably novel embodiments within Groups 4 and 5, but claim 1 in its present form does not "define a contribution" over the prior art. In the event that applicants were to elect Group 4 or 5, and claims therein found allowable, the possibility of joining either Group 6 or 7 would be considered, subject to the inclusion of whatever limitations may have been introduced into the Group 4 or 5 claims. In the event that Group 4 or 5 claims proved to be allowable, novelty would not necessarily accrue to the corresponding Group 6 or 7 claims,

but it might; in any case, if Group 4 or 5 is determined to be allowable, it would be appropriate to revisit the issue of restriction between Groups 4-5 (on the one hand), and Groups 6-7 (on the other hand). As for Groups 8 and 9, novelty would almost certainly accrue to one of these groups in the event that Group 6 or 7 proved to be allowable. Thus, in the event that Group 6 or 7 were elected, and claims therein found allowable, rejoining of Group 8 or 9 would become likely, provided that whatever limitations had been introduced into Group 6 or 7 were introduced into Group 8 or 9. As for claims 20-23 (designated by the previous examiner as Group II), in the event that Group 6 or 7 is elected, and claims therein found allowable, Group II will be rejoined therewith, provided that whatever limitations had been introduced into Group 6 or 7 were introduced into the Group II claims.

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

. . . . .

In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

- Regardless of which group is selected, election of a specific amino acid is required, that is a specific amino acid (such as arginine) that must be present within one of the

peptides, which peptide, in turn, is present in the mixture.

- In the event that any of Groups 6-9 is elected, election of a specific solid phase support medium (e.g., Toyopearl HW70EC beads) is also required.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.

✱

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 703-308-3213. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at (703) 308-2923. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
DAVID LUKTON  
PATENT EXAMINER  
GROUP 1800